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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,211	10/02/2003	Philippe Asselin	2016242-000001	9637
7590	07/01/2004			EXAMINER LE, HUYEN D
Micheline Kelly Johnson Baker, Donelson, Bearman, Caldwell & Berkowitz, PC 1800 Republic Centre 633 Chestnut Street Chattanooga, TN 37450-1800			ART UNIT 3751	PAPER NUMBER
DATE MAILED: 07/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	10/677,211	Applicant(s)	ASSELIN, PHILIPPE
Examiner	Huyen Le	Art Unit	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 June 2004.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) 7, 10, 13 and 16 is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-6, 8, 9, 11, 12, 14 and 15 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 10/02/03.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species I, drawn to Figures 1-6 in the reply filed on 06/01/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Currently, claims 1-6, 8, 9, 11, 12, 14 and 15 are readable on species I.
3. Claims 7, 10, 13 and 16 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species II, Figure 7.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1- 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Boulet (FR 1.013.219).

The Boulet reference discloses a pen holder comprising a body having a first recess 1 and a second recess 2 so that writing instruments can be inserted into the recesses, the body being flexible so that a writing instrument is removably retained when inserted into a recess.

Regarding claims 3 and 5, the first recess and the second recess are of equal dimensions shown in Figures 6-7.

Regarding claims 4 and 6, the first recess 1 and the second recess 2 are of unequal, dimensions shown in Figures 1 and 2 (recess 1 has a round shape and other hand, recess 2 has an oval shape similar to the recess 25 shown in Figure 5).

Regarding claims 11 and 12, the body is made of a rubber material which constitutes an "eraser" material.

6. Claims 1, 2, 4, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams (6,238,459).

The Adams reference discloses a pen holder comprising a body having a first recess 1 and a second recess 2 so that writing instruments can be inserted into the recesses, the body being flexible so that a writing instrument is removably retained when inserted into a recess (Figure 10, col. 5, lines 12-13).

Regarding claims 4 and 6, the first recess 1 and the second recess 2 are of unequal, dimensions

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulet (FR 1.013.219) in view of Mullins (6,276,854).

Although the Boulet reference does not specifically show that the pen holder includes advertising material, attention is directed to the Mullins reference which

discloses a pen holder 30 comprising an indicia such as an advertisement (col. 3, lines 46-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an advertising material on the Boulet pen holder in view of the teaching of the Mullins reference for decorative purposes to enhance the visual effect of the device

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulet (FR 1.013.219) in view of Chau (D 266,335).

Although the Boulet reference does not disclose the pen holder includes a clock, attention is directed to the Chau reference which showing a cap constituting a "pen holder" having a clock.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a clock on the Boulet pen holder in view of the teaching of the Chau reference for conveniently providing the time.

10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (6,238,459) in view of Mullins (6,276,854).

Although the Adams reference does not specifically show that the pen holder includes advertising material, attention is directed to the Mullins reference which discloses a pen holder 30 comprising an indicia such as an advertisement (col. 3, lines 46-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an advertising material on the Adams pen

holder in view of the teaching of the Mullins reference for decorative purposes to enhance the visual effect of the device

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams (6,238,459) in view of Chau (D 266,335).

Although the Boulet reference does not disclose the pen holder includes a clock, attention is directed to the Chau reference which showing a cap constituting a "pen holder" having a clock.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a clock on the Adams pen holder in view of the teaching of the Chau reference for conveniently providing the time.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Dopp, Blanton, Crutcher, Kimball, Williams et al, Hoiseth and Renard references show holders comprising a plurality of recesses that can retain writing instruments therein.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huyen Le whose telephone number is 703-306-5504. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HL
June 25, 2004



GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700